

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-26 are now pending in this application.

Request for Reconsideration of Finality of Office Action

Reconsideration and withdrawal of the finality of the 12/15/06 Office Action is respectfully requested. Applicants' Declarations under 37 C.F.R. §1.131 ("Declarations") were submitted along with a Request for Continued Examination (RCE), and the Declarations were objected to for the first time in a Final Office Action. A first office action after the filing of an RCE may be made final only if "(B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application." MPEP 706.07(h) VIII, MPEP 706.07(b). The goal is to develop a "clear issue" between the examiner and applicant before entry of the final rejection. See MPEP 706.07 ("Before final rejection is in order a clear issue should be developed between the examiner and applicant.") However, because the Applicant had not had a chance to respond to the Examiner's objections to the Declarations, a clear issue as to its sufficiency had not yet been established at the time the 12/15/06 Office Action issued.

The current situation is akin to that stated in MPEP 706.07(b), which states:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that

required further consideration and/or search, or (B) the issue of new matter was raised.

In the current case, it was deemed in the interest of expediting examination to file the Declarations along with an RCE, rather than file the Declarations after the previous Final Office Action (dated 5/8/06) and risk the delay associated with an Advisory Action. Accordingly, withdrawal of the finality of the 12/15/06 Office Action is respectfully requested.

Request for Entry of Supplemental Declarations

Regardless of whether the finality of the 12/15/06 Office Action is withdrawn, entry and consideration of the Supplemental Declarations submitted herewith and discussed in detail below is respectfully requested. 37 C.F.R. §1.116(e) states:

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

The Supplemental Declarations submitted herewith were not earlier presented because the objections to the Rule 131 Declarations filed with the RCE -- which were raised for the first time in the 12/15/06 Office Action -- were not previously known. The Supplemental Declarations are necessary to provide further explanation for the sufficiency of Applicants' evidence of prior invention. Accordingly, entry and consideration of the Supplemental Declarations submitted herewith is respectfully requested.

Declarations under 35 U.S.C. §1.131

The Final Office Action raises several objections to the Declarations. Each will be addressed in turn.

“Document ‘Exhibit A’ and ‘Exhibit C’ does not provide any information to prove that the invention was completed prior to the effective date of Hamaguchi et al.” Final Office Action at p. 3.

As stated in the Declarations at paragraphs 5.a. through 5.c., Exhibits B and C are the attachments to the e-mail in Exhibit A. Therefore, Exhibits A, B and C are to be read together as an e-mail having two attachments. Both inventors provided evidence by way of their statements that “At least by November 02, 2000, we conceived in Santa Clara, CA the ideas set forth in Claims 1-26 of the ‘311 application.” (Declarations, paragraphs 5). This evidence is corroborated by the date of conception of “11.02.2000” printed on the second page of Exhibit B. Accordingly, paragraph 5 of both Declarations and Exhibits A through C provide information demonstrating conception of the invention prior to the effective date of Hamaguchi et al.

Submitted herewith are Supplemental Declarations of inventors David Blight and Elaine Lusher (“Blight Supplemental Declaration” and “Lusher Supplemental Declaration,” respectively). Mr. Blight provides further evidence by way of his statements that conception of Claims 1-26 occurred on November 2, 2000, prior to the filing date of Hamaguchi et al. Mr. Blight was employed by Palm in the Fall, 2000 time frame to research location-based services concepts. Blight Supplemental Declaration, ¶2. He reported to Ms. Lusher. Blight at ¶3. Mr. Blight drafted the invention disclosure form (Exhibit B) and its attachment (Exhibit C). Blight at ¶¶5. Mr. Blight states: “To the best of my recollection, I spoke with Elaine Lusher on November 2, 2000 to discuss with her the core concepts that would later become the subject matter of Exhibits B and C and the claims of the ‘311 Application.” Blight at ¶ 8. Mr. Blight memorialized the November 2, 2000 conception date by writing it on the invention disclosure form. Blight at ¶¶ 7 and 14. Therefore, Exhibit B provides documentary corroboration of the November 2, 2000 conception date. (Note, however, that PTO rules do not require corroboration. “Also, in interference practice, conception, reasonable diligence, and reduction to practice require corroboration, whereas averments made in a 37 CFR 1.131 affidavit or declaration do not require corroboration; an applicant

may stand on his or her own affidavit or declaration if he or she so elects. *Ex parte Hook*, 102 USPQ 130 (Bd. App. 1953).”)

Accordingly, these statements provide further supplemental evidence that the features of Claims 1-26 were conceived prior to the filing date of Hamaguchi et al. Completion of the invention is further evidenced by diligence from a time prior to Hamaguchi et al.’s filing date to a constructive reduction to practice (i.e., the filing date of the present application), which is discussed on page 15 below.

“Document ‘Exhibit C’ does not provide information to prove who is/are the inventor(s) of the concept being disclosed in the document and when the concept being disclosed in the document was completed.”

The Declarations state “we conceived” at paragraphs 1 and 5 and they refer to Exhibit C in paragraph 5.c. Therefore, the Declarations provide evidence demonstrating that Mr. Blight and Ms. Lusher are the co-inventors of the concepts disclosed in Exhibit C. Also, Exhibits B and C provide evidence that the features in Exhibit C, an attachment to Exhibit B, were co-invented by Mr. Blight and Ms. Lusher. Page 2 of Exhibit B refers to a Brief Description of the Invention which is “Attached,” which provides evidence that the Invention Disclosure Form of Exhibit B had an attachment. Exhibit C is titled “Resource Location through Location History,” (Exh. C, p. 1) which is the same subject of the Invention Disclosure Form of Exhibit B, “Location History System” (Exh. B, p. 1). Accordingly, the evidence demonstrates that Exhibit C was an attachment to Exhibit B, demonstrating that Mr. Blight and Ms. Lusher were the co-inventors of the concepts disclosed in Exhibit C (as stated on p. 1 of Exhibit B naming the inventors as Mr. Blight and Ms. Lusher.)

The Blight and Lusher Supplemental Declarations provide further evidence showing that it was Mr. Blight and Ms. Lusher who are the inventors of the concepts disclosed in Exhibit C. Blight Supplemental Declaration, ¶6; Lusher Supplemental Declaration, ¶5.

The question of “when the concept being disclosed in the document was completed,” is answered, *inter alia*, by the Blight Supplemental Declaration, which states: “To the best of

my recollection, I spoke with Elaine Lusher on November 2, 2000 to discuss with her the core concepts that would later become the subject matter of Exhibits B and C and the claims of the '311 Application." Blight at ¶ 8. As mentioned, the November 2, 2000 date is corroborated by p. 2 of Exhibit B. Accordingly, it has been demonstrated that Mr. Blight and Ms. Lusher are the co-inventors of the contents of Exhibit C and that the core concepts were conceived at least as early as November 2, 2000.

"Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant."

In addition to the portions of Exhibits B and C identified above, below is a chart showing where each element of each of Claims 1-26 is shown in Exhibit C.

Claim	Exhibit C
1. (Previously Presented) A system for locating access to wireless resources, comprising: a portable electronic device including a short range radio frequency (RF) transceiver;	One of the main difficulties of short range wireless devices such as Bluetooth or 802.11 is that the coverage area of each transmitter is relatively small. PANs are extremely effective for adhoc networks with stationary components (for example an office), or where all components move together (cell phone, PDA, and other mobile devices all attached to a user).
a database program running on the portable electronic device, the database program configured to store a history of wireless station information and available resource information,	The central part of this invention is the database of resources and their locations.
the wireless station information being representative of wireless stations coming in communications with the short range RF transceiver as the portable electronic device is being moved through an environment, and	This invention involves a mechanism by which a mobile device records its location, and available resources associated with that location as it moves around.
the available resource information being correlated with the wireless station information and the available	The database should be storing information associated with both wireless stations (wireless transmitter) detected, and resources

Claim	Exhibit C
resource information being distinct from and representative of the resources available through the wireless stations.	available through wireless stations. Any specific wireless station may have multiple resources associated with it, and likewise each resource may be available through multiple wireless stations.
2. (Original) The system of claim 1, wherein the portable electronic device is a handheld computer.	PANs are extremely effective for adhoc networks with stationary components (for example an office), or where all components move together (cell phone, PDA, and other mobile devices all attached to a user).
3. (Original) The system of claim 1, wherein the short range RF transceiver is a Bluetooth transceiver.	One of the main difficulties of short range wireless devices such as Bluetooth or 802.11 is that the coverage area of each transmitter is relatively small.
4. (Original) The system of claim 1, wherein the short range RF transceiver is a IEEE 802.11 transceiver.	One of the main difficulties of short range wireless devices such as Bluetooth or 802.11 is that the coverage area of each transmitter is relatively small.
5. (Original) The system of claim 1, wherein the wireless station information includes the type of wireless transceiver being used by the wireless station.	The following information may be in the database: <ul style="list-style-type: none"> • Wireless station information <ul style="list-style-type: none"> • Wireless technology (Bluetooth, 802.11, etc)
6. (Original) The system of claim 1, wherein the wireless station information includes an address of the wireless station.	<ul style="list-style-type: none"> • Address (MAC address)
7. (Original) The system of claim 1, wherein the wireless station information includes information representative of the location of the wireless station.	<ul style="list-style-type: none"> • Location information <ul style="list-style-type: none"> • Location • Error • Location determination method
8. (Original) The system of claim 1, wherein the wireless station information includes a timestamp representative of a time that the portable device was in range of the wireless station.	<ul style="list-style-type: none"> • Timestamp (last detection)
9. (Original) The system of claim 1, wherein the resource information includes a resource identifier.	<ul style="list-style-type: none"> • Resource information <ul style="list-style-type: none"> • Resource identifier

Claim	Exhibit C
10. (Original) The system of claim 1, wherein the resource information includes a resource description.	<ul style="list-style-type: none"> Resource description. This description is used to describe the resource. It may be used in searching for particular resources.
11. (Original) The system of claim 1, wherein the resource information includes keywords relating to the resource.	<ul style="list-style-type: none"> Keywords
12. (Original) The system of claim 1, wherein the resource information includes attributes for an object oriented data description.	<ul style="list-style-type: none"> Attributes in an object oriented data description
13. (Original) The system of claim 1, wherein the resource information includes a listing of associated wireless stations.	<ul style="list-style-type: none"> Associated wireless stations
14. (Previously Presented) A method of locating access to resources in an environment, comprising: <div style="padding-left: 40px;">roaming within an environment with a portable electronic device having a short range radio frequency (RF) transceiver;</div>	<p>PANs are extremely effective for adhoc networks with stationary components (for example an office), or where all components move together (cell phone, PDA, and other mobile devices all attached to a user).</p> <p>This invention involves a mechanism by which a mobile device records its location, and available resources associated with that location as it moves around.</p>
<div style="padding-left: 40px;">scanning for wireless enabled devices within range of the RF transceiver of the portable device;</div>	This invention involves a mechanism by which a mobile device records its location, and available resources associated with that location as it moves around.
<div style="padding-left: 40px;">storing wireless station information relating to the wireless enabled devices in a database;</div>	The central part of this invention is the database of resources and their locations.
<div style="padding-left: 40px;">storing available resource information distinct from and relating to the resources coupled to and available through the wireless station in the database; and</div>	This invention involves a mechanism by which a mobile device records its location, and available resources associated with that location as it moves around.

Claim	Exhibit C
accessing, on the portable electronic device, the database including the wireless station information and the available resource information.	Search through the database and find a location where the specified resource may be accessed. This involved first matching the specified resource with those in the database. The matches are then compared to find the closest (or other selection criteria)
15. (Original) The method of claim 14, further comprising: querying the database for a specified resource.	The search algorithm is responsible for find the closest resource station to the the mobile device's current location. Input: <ul style="list-style-type: none"> • Current location • Desired resource <ul style="list-style-type: none"> • Preferences (optional)
16. (Original) The method of claim 15, further comprising: performing a keyword search of the database.	<ul style="list-style-type: none"> • Keywords
17. (Original) The method of claim 15, further comprising: providing location information relating to accessing the specified resource.	<ul style="list-style-type: none"> • Location information <ul style="list-style-type: none"> • Location • Error • Location determination method
18. (Original) The method of claim 17, wherein the location information includes a set of directions.	Optionally a navigation application may be used to direct the mobile device to a location where the resource is available.
19. (Original) The method of claim 17, wherein the location information includes a map.	8. The system should be able to work with a map system, to provide navigation.
20. (Previously Presented) A method of locating access to resources in an environment, comprising: moving through an environment with a portable electronic device having a short range radio frequency (RF) transceiver;	One of the main difficulties of short range wireless devices such as Bluetooth or 802.11 is that the coverage area of each transmitter is relatively small. PANs are extremely effective for adhoc networks with stationary components (for example an office), or where all components move together (cell phone, PDA, and other mobile devices all attached to a user). This invention involves a mechanism by which a mobile device records its location,

Claim	Exhibit C
	and available resources associated with that location as it moves around.
receiving information distinct from and relating to wirelessly accessible resources coupled to a wireless station;	This invention involves a mechanism by which a mobile device records its location, and available resources associated with that location as it moves around.
storing the information in a database on the device; and	The central part of this invention is the database of resources and their locations.
accessing the database information according to a specific query.	The search algorithm is responsible for find the closest resource station to the mobile device's current location. Input: <ul style="list-style-type: none"> • Current location • Desired resource <ul style="list-style-type: none"> • Preferences (optional) • Selection criteria <ul style="list-style-type: none"> • Closest, last encountered, ...
21. (Original) The method of claim 20, wherein the environment is a metropolitan area.	A mobile device is moving through a metropolitan area.
22. (Original) The method of claim 20, wherein the environment is a shopping district.	As the device travels it occasionally picks up information from local commercial entities (stores, restaurants).
23. (Original) The method of claim 20, wherein the environment is a shopping mall.	As the device travels it occasionally picks up information from local commercial entities (stores, restaurants).
24. (Original) The method of claim 20, wherein the environment is an office building.	Consider a mobile device within an office complex.
25. (Original) The method of claim 20, wherein the environment is a corporate campus.	A mobile device is turned on for the first time in a corporate campus.
26. (Original) The method of claim 20, wherein the environment is an academic campus.	A mobile device is turned on for the first time in a corporate campus.

Conception of Claims 1-26 is thus shown in particular by at least the invention disclosure form of Exhibit B (specifically, sections 1, 2, 3, 4 and 8, as well as sections 6 and 7 which refer to the attached Exhibit C), Exhibit C (specifically, the portions set forth above in the chart), the Declarations at paragraphs 5 and 6, and the Blight Supplemental Declaration at

paragraphs 2, 3, and 5-8 and the Lusher Supplemental Declaration at sections 2-5.

Accordingly, it is respectfully submitted that a clear explanation of the exhibits pointing out exactly what facts are established and relied on has been provided.

“The declarant did not provide evidence or proof of reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of Hamaguchi et al.”

For purposes of swearing behind Hamaguchi et al., Applicants are relying on their May 30, 2001 filing date as a constructive reduction to practice. 37 C.F.R. §1.131(b) (“The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.”) (emphasis added).

“The declarant did not provide evidence to establish diligence from a date prior to the date of a subsequent reduction to practice or to the filing of application.”

The diligence of 35 U.S.C. 102(g) relates to reasonable “attorney-diligence” and “engineering-diligence” (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved....” *Emery v. Ronden*, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974). Applicants were diligent in the short period between November 29, 2000 (the filing date of Hamaguchi) and March 27, 2001. Applicants’ attorney was diligent in the period from March 27, 2001 through May 30, 2001.

Mr. Blight states in the Blight Supplemental Declaration that the concept that led to the present patent application was one of approximately 10 concepts he had been working on in the Fall, 2000 time frame. Blight Supplemental Declaration, ¶2, 4 and 9. In the Fall, 2000 time frame, Mr. Blight created a list of the approximately 10 concepts for potential submission to Palm, Inc. for consideration for filing as patent applications. *Id.* at ¶4. Between November 2, 2000 and March 26, 2001, Mr. Blight worked on reducing to writing

one or more of the approximately 10 concepts. Id. at ¶9. Palm, Inc. also had a vacation between Christmas and New Year's spanning 2000-2001. Id. at ¶10. Mr. Blight further recalls working on drafting Exhibits B and C at various times throughout the period of January 2001 through March 26, 2001. Id. at ¶11. He was also working on reducing to writing others of the approximately 10 concepts in the January 2001 through March 26, 2001 time frame. Id. at ¶12. He further recalls submitting at least Exhibit C to Ms. Lusher at least once in the early January 2001 to March 26, 2001 time frame for review and comment. Id. at ¶13. On March 26, 2001, Mr. Blight submitted Exhibits B and C to Henry Ohab, Senior Patent Attorney at Palm, Inc. Id. at ¶14 and Exhibit A. Accordingly, Mr. Blight and/or Ms. Lusher were diligent in working on the invention disclosure form and attachment or excused because of their vacation and work on other concepts for the entire period extending from before November 29, 2000 until March 26, 2001.

Between March 27, 2001 and the filing date of May 30, 2001, Applicants' attorney, Alistair K. Chan, Ph.D., was diligent in preparing and filing the patent application. On March 27, 2001, he received an e-mail from Mr. Ohab asking that Foley & Lardner LLP prepare a patent application. Chan Declaration, ¶¶3-4. At the time he received this request, Dr. Chan had a backlog of patent applications, prosecution, and other work which he was working on. Id. at ¶5. Between the period of March 27, 2001 and May 20, 2001, Dr. Chan worked on the backlog. Id. at ¶6. On May 21, 2001, he began work drafting the patent application and worked on it regularly until he filed the patent application on May 30, 2001. Id. at ¶7. Accordingly, Dr. Chan was diligently working on the patent application or excused because of the backlog for the entire period extending from March 27, 2001 through May 30, 2001.

1. Rejection of Claims 1-4, 6, 7, and 9-26 Under 35 U.S.C § 102(e) as Anticipated by Hamaguchi et al.

In Section 3 of the Office Action, claims 1-4, 6, 7, and 9-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Hamaguchi et al. (U.S. Patent Appl. Publ. No. 2002/0010617).

Applicants respectfully traverse these rejections. The rejections rely in whole on Hamaguchi et al. However, the Applicants respectfully submit that Hamaguchi et al. is unavailable as a prior art reference against claims 1-4, 6-7, and 9-26 of the present application.

Declarations and Supplemental Declarations by the inventors and the prosecuting attorney pursuant to 37 C.F.R. § 1.131 have been provided herewith, which provide evidence that the subject matter recited in claims 1-4, 6-7, and 9-26 was invented prior to the filing date of Hamaguchi et al. Hamaguchi et al. was filed on November 29, 2000 as U.S. Patent Application No. 09/725,213.

The Declarations and related documents establish that the subject matter recited in claims 1-4, 6-7, and 9-26 was conceived at least by November 2, 2000. Attachments to the Declaration include various information that establishes that the subject matter recited in claims 1-4, 6-7, and 9-26 was conceived by the inventors at least by November 02, 2000, which is before the November 29, 2000 filing date of Hamaguchi et al.

Accordingly, the Applicants submit that Hamaguchi et al. is unavailable as a prior art reference against claims 1-4, 6-7, and 9-26 of the present application, and therefore respectfully request that the rejection of claims 1-4, 6-7, and 9-26 be withdrawn.

2. Rejection of Claims 5 and 8 Under 35 U.S.C. § 103(a) as Being Unpatentable Over Hamaguchi et al.

In section 5 of the Office Action, claims 5 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hamaguchi et al. Applicants respectfully submit that as described above, Hamaguchi et al. is not available as a prior art reference. Accordingly, Applicants request the withdrawal of the rejection of claims 5 and 8 under 35 U.S.C. § 103(a) which relies on the use of Hamaguchi et al. in combination with knowledge of one of ordinary skill in the art. Accordingly, Applicants respectfully submit that claims 5 and 8 are therefore allowable.

3. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.


The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 2-28-07

FOLEY & LARDNER LLP
Customer No.: 26371
Telephone: (414) 297-5571
Facsimile: (414) 297-4900

By 
Steven C. Becker
Attorney for Applicants
Registration No. 42,308